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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/748,870 | 12/29/2003 | Jeffrey A. Dean | Google-35APP (GP-090-00-U | 3713 |

26479 7590 03/27/2006

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| EXAMINER | |
|---|---|
| TSUI, WILSON W | |
| **ART UNIT** | **PAPER NUMBER** |
| 2178 | |

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/748,870 | DEAN ET AL. | |
| | Examiner | Art Unit | |
| | Wilson Tsui | 2178 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *29 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *20050225*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1. This office action is filed in response to the application filed on 12/29/2003, and IDS filed on 2/25/2005.

2. Claims 1-16 are pending, claims 1, 7, 9, and 15 are independent claims.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 7 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Graham et al (US Patent: 6,804,659, published: Oct 12, 2004, filed Jan. 14, 2000).

With regards to claim 7, Graham et al teaches a method comprising:

- *Accepting document information* (column 5, lines 46-48: whereas, any web page document that comprises document information, is used as input).
- *Using the document information to determine content in addition to content of the document*: whereas, based on the concepts extracted from the document information, additional content is determined (in this case an ad is the additional content) (column 6, lines 34-39).
- *Using the determined content, determining further content*: whereas, the determined content is the ad that is most relevant (Fig 11A, reference number 1512, column 15, lines 13-19). A second ad (Fig. 11A, reference number 1514) is displayed as further content, and determined by choosing a second ad based on

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- *Using the determined content, determining further content*: whereas, the determined content is the ad that is most relevant (Fig 11A, reference number 1512, column 15, lines 13-19). A second ad (Fig. 11A, reference number 1514) is displayed as further content, and determined by choosing a second ad based on

a ranking score, which indicates that it is broader in terms of concept than the first ad (column 15, lines 13-19).

- *Combining at least a portion of content of the document and at least a portion of the determined content, and at least a portion of the determined content, and at least a portion of the determined further content for presentation to the user* (Fig. 11A, column 15, lines 1-23: whereas, the content of the document, the determined content (reference number 1512 is an ad representing the determined content), and the further determined content (reference number 1514) are combined into a browser screen (reference 1503)).

With regards to claim 15, for an apparatus performing a method similar to the method in claim 7, is rejected under the same rationale.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al (US Patent: 6, 804,659, published: Oct 12, 2004, filed Jan. 14, 2000).

With regards to claim 1, Graham et al teaches a method comprising:

- *Accepting document information* using web page content, as similarly described in claim 7, and is rejected under the same rationale.

- *Using the document information to determine content in addition to content of the document*, as similarly described in claim 7, and is rejected under the same rationale.
- *Using the determined content, determining further content*, as similarly described in claim 7, and is rejected under the same rationale.
- *Combining at least a portion of content of the document and at least a portion of the determined content, and at least a portion of the determined content for presentation to the user*, as similarly described in claim 7, and is rejected under the same rationale.

However, although Graham et al teaches that the document information accepted is from a web page, Graham et al does not expressly teach that *the document is at least one ad*. Yet, Graham et al also teaches that the advertisements displayed are web page content as well (column 4, lines 51-54: whereas, the advertisements are displayed in a web browser).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Graham et al's system, such that the document information accepted; would have been a web page comprising an ad as also taught by Graham et al. The combination would have allowed the client of Graham et al's system to have obtained additional information based on the ad content retrieved.

With regards to claim 9, for an apparatus performing a similar method to claim 1, is rejected under the same rationale.

5. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al (US Patent: 6,804,659, published: Oct 12, 2004, filed Jan. 14, 2000) in further view of Bhagavath et al (US Patent: 6,505,169 B1, published: Jan. 7, 2003, filed: Jan. 26, 2000) and ProductReview (Edmunds.com, Page 1, Jan. 22, 2001).

With regards to claim 2, which depends on claim 1, Graham et al teaches a method comprising:

- *The at least one ad*, in claim 1, and is rejected under the same rationale.
- *The determined content*, in claim 1, and is rejected under the same rationale.
- An ad database, which stores advertisement meta-data for web advertising objects/pages (column 5, lines 17-18: whereas, advertisements are mapped to concept related metadata). However, Graham et al does not teach the at least one ad *is for a product and wherein* the determined content *is a review for the product.*

Bhagavath et al teaches ads with associated metadata, which are stored in a cache/database (Fig. 1, reference number 125, column 4, lines 35-40). Furthermore, Bhagavath et al teaches the ad - associated meta data includes display constraints (column 6, 30-34).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Graham et al's ad-metadata system to have further included display constraints as taught by Bhagavath et al. The combination would have allowed Graham et al's ad selection system to have conditionally displayed ads, not just by concept strength, but also based on additional display constraints.

However, although Graham and Bhagavath et al teach a method for selecting ads based on additional display constraints, they do not expressly teach the at least one ad *is for a product and wherein the determined content is a review for the product.*

ProductReview teaches the *at least one ad is for a product and wherein the determined content is a review for the product* (page 1: whereas, a car is the product, and through inherent display constraints, only additional content concerning a review of the particular car is displayed on the right hand side of the page).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Graham and Bhagavath et al's display constraints to have further included the constraint to display a review for a product, when a product is being browsed, as taught by ProductReview. The combination of Graham et al, Bhagavath et al, and ProductReview, would have allowed Graham's system to have been able to provide product review information when the ad is a product.

With regards to claim 10, which is dependent on claim 9, for an apparatus performing a similar method to claim 2, is rejected under the same rationale.

6. Claims 3, 8, 11, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al (US Patent: 6,804,659, published: Oct 12, 2004, filed: Jan. 14, 2000) in further view of Bhagavath et al (US Patent: 6,505,169 B1, published: Jan. 7, 2003, filed: Jan. 26, 2000) and CNET (CNET.COM, page 1, December 7, 2001).

With regards to claim 3, which depends on claim 1, Graham et al teaches a method comprising:

- *The at least one ad*, in claim 1, and is rejected under the same rationale.

- *The determined content*, in claim 1, and is rejected under the same rationale.
- An ad database, which stores advertisement meta-data for web advertising objects/pages (column 5, lines 17-18: whereas, advertisements are mapped to concept related metadata).
- Furthermore, although Graham and Bhagavath et al teach a method for selecting ads based on additional display constraints, as explained in claim 2, they do not expressly teach the at least one ad *is for a service and wherein* the determined content *is a review for the service*.

CNET teaches at least one ad *is for a service and wherein* the determined content *is a review for the service* (page 1: whereas, 'PC Connection' is the name of the service, and the review is indicated by a "star" ranking system).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Graham et al and Bhagavath et al's display constraints to have further included the constraint to have displayed a review for a service, when a service was being browsed, as taught by CNET. The combination of Graham et al, Bhagavath et al, and CNET, would have allowed Graham et al's system to have been able to have provided service review information when the ad was a service.

With regards to claim 8, which depends on claim 7, Graham et al, Bhagavath et al, and CNET teach *wherein the determined content is one of a review*, in claim 3, and is rejected under the same rationale.

Furthermore, Graham et al teaches *wherein the further determined content is at least one ad relevant to the determined content*, as explained in claim 7, and is rejected under the same rationale.

With regards to claim 11, which depends on claim 9, for an apparatus performing a method similar to claim 3, is rejected under the same rationale.

With regards to claim 16, which depends on claim 15, for an apparatus performing a similar method to the method in claim 8, is rejected under the same rationale.

7. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al (US Patent: 6,804,659, published: Oct 12, 2004, filed: Jan. 14, 2000) and Bhagavath et al (US Patent: 6,505,169 B1, published: Jan. 7, 2003, filed: Jan. 26, 2000) in further view of MSN (MSN.COM, page 1, Dec. 7, 2000).

With regards to claim 4, which depends on claim 1, Graham et al teaches a method comprising:

- *The at least one ad*, in claim 1, and is rejected under the same rationale.
- *The determined content*, in claim 1, and is rejected under the same rationale.
- An ad database, which stores advertisement meta-data for web advertising objects/pages (column 5, lines 17-18: whereas, advertisements are mapped to concept related metadata).
- Furthermore, although Graham and Bhagavath et al teach a method for selecting ads based on additional display constraints, as explained in claim 2, they do not

expressly teach the at least one ad *is for a product or service and wherein* the determined content *is a news story about the product or service*.

MSN teaches at least one ad *is for a product or service and wherein* the determined content *is a news story about the product or service* (MSN, page 1: whereas, MSN Messenger is the service, and news about MSN Messenger is provided as additional content).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Graham et al and Bhagavath et al's display constraints to have further included the constraint to display a news story about a service as taught by MSN. The combination of Graham et al, Bhagavath et al, and MSN, would have allowed Graham et al's system to have been able to have provided service news information when the ad was a service type.

With regards to claim 12, which is depends on claim 9, for an apparatus performing a method similar to claim 4, is rejected under the same rationale.

8. Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al (US Patent: 6,804,659, published: Oct 12, 2004, filed: Jan. 14, 2000) in further view of Bowman et al (US Patent: 6,006,225, published: Dec. 21, 1999, filed: Sep. 1, 1998).

With regards to claim 5, which depends on claim 1, Graham et al teaches a method comprising t*he determined content*, in claim 1, and is rejected under the same rationale.

However, Graham et al does not teach the determined content *is a search query related to the document.*

Bowman et al teaches the determined content *is a search query related to the document* (column 1, lines 55-67, Fig. 9: whereas, based on the contents of a document, a suggested query is presented to the user).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Graham et al's system for determining content to have also included Bowman et al's system for suggesting a query based on document content. The combination would have allowed Graham et al's system to have been able to "efficiently locate the most relevant terms" (Bowman et al, column 2, lines 23-24).

With regards to claim 13, for an apparatus performing a similar method as in claim 5, is rejected under the same rationale.

9. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al (US Patent: 6,804,659, published: Oct 12, 2004, filed: Jan. 14, 2000) in further view of Weaver (US Application: US 2004/0093558 A1, published: May 13, 2004, filed: Oct. 29, 2003, EEFD: Oct 29, 2002).

With regards to claim 6, which depends on claim 1, Graham et al teaches a method comprising *the determined content*, in claim 1, and is rejected under the same rationale. Furthermore, Graham et al teaches determining the content by going through an advertisement database for related concepts, as explained in claim 1. However, Graham et al does not teach the determined content *is a message from a user group.*

Weaver teaches a message database that stores *messages from a user group* (claim 2).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Graham et al's advertisement database, which associated advertisements with concepts; to a database that stored messages (as taught by Weaver) which associated messages with concepts. The combination would have allowed Graham et al's system to have been able to determine the most appropriate user group message based on the document content.

With regards to claim 14, which depends on claim 9, for an apparatus performing a similar method to claim 6, is rejected under the same rationale.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Do Rosario Botelho et al. (US Application: 2002/0069105 A1, published: Jun. 6, 2002, filed: Dec. 1, 2000): This reference teaches the use of metadata and combining portions of content and annotated data.
- Angles et al (US Patent: 5,933,811, published: Aug. 3, 1999, filed: Aug. 20, 1996): This reference teaches combining portions of advertising data with content.
- Herz (US Patent: 6,460,036 B1, published: Oct 1, 2002, filed: Dec. 5, 1997): This reference teaches use of ranking for display of advertisements.

- Samar (US Patent: 6,563,514 B1, published: May 13, 2003, filed: Apr. 13, 2000): This reference teaches the use of dynamically collecting information based on content of web page.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wilson Tsui whose telephone number is (571)272-7596. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

W.T. 3/20/2006

**STEPHEN HONG**
**SUPERVISORY PATENT EXAMINER**

Wilson Tsui
Patent Examiner
Art Unit: 2178
March 20, 2006